

Application Serial No. 10/749270
Amendment dated February 9, 2006
Response to office action dated August 9, 2005

REMARKS/ARGUMENTS

The preceding amendments and following remarks are submitted in response to the Final Office Action mailed August 9, 2005 and the Advisory Action mailed December 8, 2005. With this Amendment, claims 20, 26, 32 and 37 have been amended and claims 23-25, 29-31, 34-36 and 40-42 have been cancelled. Claims 20-22, 26-28, 32-33 and 37-39 remain pending in this application. Reconsideration, reexamination and allowance of all pending claims are respectfully requested.

Claim Rejections—35 U.S.C. § 102

Claims 20-42 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Becker et al.* (U.S. Patent No. 6,165,152) (hereinafter "Becker '152"). Applicants respectfully traverse this rejection. In order to anticipate a claim, a reference must disclose each and every element of the claim. *See M.P.E.P. §2131.*

Applicants assert that the Becker '152 reference fails to anticipate the delivery sheath of claims 20-22, 26-28, 32-33 and 37-39. The Becker '152 reference appears to disclose a balloon catheter (10) having an elongated catheter shaft (11), an inflatable balloon (14), and an adapter (16). The catheter shaft (11) apparently includes an outer tubular member (20), an inner tubular member (21), and an inflation lumen (22) in fluid communication with the inflatable balloon (14).

It was indicated in the Office Action that the balloon of Becker '152 was shaped as described in the independent claims of the present application, and the Office Action apparently included the balloon as part of the sheath. As mentioned in a prior response, Applicants disagree that the balloon is part of a sheath. However, the claims have been amended to further define a single walled distal portion as having the shape described in

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claims 20, 26, 32 and 37. The amended independent claims recite a delivery sheath that has an embolic protection filter. These claims also recite a distal portion of the sheath that has a single wall, the distal portion also defining a lumen. The lumen can accommodate a filter when the filter is in its contracted state.

A basis for these amendments can be found at several locations within the specification. The distal portion of the sheath is described as being a wall having a certain thickness, where the thickness is reduced in a distal direction. (See, for example, the paragraph beginning at page 6, line 22.) A sheath with a wall that has a thickness could be described as a single walled structure. This is also reinforced by the figures, especially Figure 3, which shows the reduction in wall thickness.

Becker '152 does not disclose each and every element of this claim. No portion along the length of the device in Becker '152 can be described as a single walled distal portion having the shape and configuration as described in the independent claims. In addition, Becker '152 does not describe an embolic protection filter. Because at least these elements of the independent claims are missing from Becker '152, Becker '152 cannot anticipate the independent claims. Applicants thus assert that the independent claims are allowable. Because they are dependent on allowable independent claims and because they recite additional patentably distinct elements, Applicants respectfully assert that dependent claims 21, 22, 27, 28, 33, 38 and 39 are also allowable.

With respect to claims 25, 31, and 36, the Office Action further states, "the function recitation that the delivery sheath is configured to accommodate an intravascular emboli capturing device therein has not been given patentable weight because it is in narrative form." Although Applicant respectfully disagrees with the rejection of these

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claims, these claims have been cancelled in the amended claim set, rendering the rejection moot.

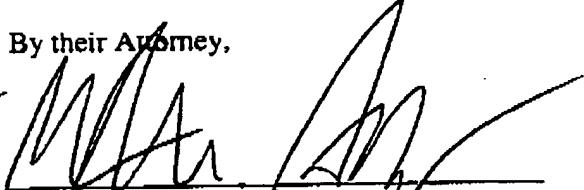
Reexamination of the claims in due course is respectfully requested. Applicants respectfully submit that all pending claims are in condition for allowance; issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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